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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,687	09/29/2003	Cheng Shing Lai	LAIC3027/EM	7418
23364	7590	03/10/2006	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			ALAM, UZMA	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/671,687

Applicant(s)

LAI ET AL.

Examiner

Uzma Alam

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This action is responsive to the amendment filed January 6, 2006. Claims 1, 6, and 10 are currently amended. Claims 1-13 are pending. Claims 1-13 represent a e-mail notification method.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Horstmann et al. US Patent No. 6,779,022. Hortsmann teaches the invention as claimed including mail server with forwarding capabilities (see abstract).

3. As per claim 1, Horstmann teaches a method of receiving email by a electronic communication device, wherein a mail server is connected to at least one electronic device via a network said mail server saving at least one notice condition, and said notice condition individually corresponding to an electronic communication device; and wherein when said mail sever finds a new mail in said mail server, said electronic communication device and mail server perform the following steps:

firstly, the mail server determining whether or not said new mail matches said notice condition (receiving email and determining if any filters apply to it; column 4, line 1-18, lines 36-65; column 6, lines 54-67);

Art Unit: 2157

if said new mail matches said notice condition, then said mail server searching for a corresponding electronic communication device according to said notice condition (determining what filter applies to the message; column 4, line 1-18, lines 36-65; column 6, lines 54-67);

said mail server sending out a notice message to said corresponding electronic communication device to inform a user that the new mail has been found in said mail server so that the user may, at the user's option, immediately retrieve said new mail (forwarding the email or parts of it to a device remote from the server; column 1, lines 55-62; column 4, lines 1-18, lines 36-65; column 6, lines 54-67; column 8, lines 46-67; column 9, lines 1-10).

4. As per claim 2, Horstmann teaches the method of receiving email by electronic communication device of claim wherein said electronic communication device sets up said notice condition for said mail server via said network (the devices are connected through the Internet; column 2, lines 62-67).

5. As per claim 3, Horstmann teaches the method of receiving email by electronic communication device of claim 1, wherein said notice condition set in the mail server of the electronic communication device comprises an email account, a password, a telephone number of electronic communication device that receives the notice, a key information, and a notice message (the electronic device receives information about the email received at the server; column 5, lines 1-11).

Art Unit: 2157

6. As per claim 4, Horstmann teaches the method of receiving email by electronic communication device of claim 3, wherein said key information comprises a sender, a sender's email account, and at least one specific character (column 8, lines 44-65).

7. As per claim 5, Horstmann teaches the method of receiving email by electronic communication device of claim 3, wherein said notice message comprises a sender, a sender's email account, at least one specific character, time of receiving mail, mail title, and mail summary (column 8, lines 44-65)

8. As per claim 6, Horstmann teaches the method of receiving email by electronic communication device of claim 1, wherein said mail server performs the following steps after detecting a new mail:

firstly, determining whether or not the content of the email matches a notice condition saved in said mail server (determining if the content of an email warrants an action by the server; column 4, line 1-18, line 36-46);

if the email matches the notice condition saved in said mail server, then searching a corresponding electronic communication device and a notice message according to said notice condition (checking for an appropriate filter with which to forward the message; column 4, line 1-18, line 36-46); and

sending said notice message to said corresponding electronic communication device (sending the message to a device located remotely from the server; column 4, lines 1-18, lines 36-46).

9. As per claim 7, Horstmann teaches the method of receiving email by electronic communication device of claim 6, wherein, when said email has content not matching the notice condition saved in said mail server, said mail server processes a general email processing procedure (column 3, lines 66-67; column 4, lines 1-8).

10. As per claim 8, Horstmann teaches the method of receiving email by electronic communication device of claim 6, wherein said mail server converts said notice message into a message of preset format and sends said message to said corresponding electronic communication device, before sending said notice message to said corresponding electronic communication device (the notice is set in a format compatible with the device; column 4, lines 48-67; column 9, lines 1-9).

11. As per claim 9, Horstmann teaches the method of receiving email by electronic communication device of claim 8, wherein said electronic communication device follows a general message processing mode to issue a beep to a loudspeaker or display an icon on the screen of said electronic communication device when said communication device receives said message (column 9, lines 38-45).

12. As per claim 10, Horstmann teaches the method of receiving email by electronic communication device of claim 1, wherein said electronic communication device processes said

Art Unit: 2157

notice message according to the following steps after said notice message is sent to the corresponding electronic communication device and said notice message is read:

firstly, displaying an operating menu on the screen of said electronic communication device, said operating menu comprising an immediate processing mode and a later processing mode (column 9, lines 38-45);

determining whether or not to choose the immediate processing mode; if the immediate processing mode is chosen, enabling a mail receiving module preset in said electronic communication device, and connecting said mail receiving module to said mail server according to said notice message via a network (column 9, lines 38-67);

retrieving an email matching with the notice message from said mail server according to said notice message (column 9, lines 38-67); and

receiving an email matching with the notice message sent from said mail server (column 9, lines 38-67).

13. As per claim 11, Horstmann teaches the method of receiving email by electronic communication device of claim 10, wherein, when said later processing mode is chosen, a notice management module preset in said electronic communication device is used to save said notice message in a storage medium of said electronic communication device (column 9, line s46-67; column 10, lines 1-5)

14. As per claim 12, Horstmann teaches the method of receiving email by electronic communication device of claim 11, wherein said electronic communication device processes the

Art Unit: 2157

procedure read from the notice message after said notice management module saves said notice message in said storage medium, provided said notice management module is enabled and said notice message is read (column 9, line s46-67; column 10, lines 1-5).

15. As per claim 13, Horstmann teaches the method of receiving email by electronic communication device of claim 1, wherein said electronic communication device is a mobile phone, and after said mobile phone connects to said mail server via network, said mobile phone uses a notice management module to set said notice condition in said mail server, and saves said notice condition in said mail server, and uses said notice management module to configure the receiving mail server (column 9, line s46-67; column 10, lines 1-5).

### ***Response to Arguments***

16. Applicant's arguments filed January 6, 2006 have been fully considered but they are not persuasive.

17. In response to applicant's argument that the reference Hortsman et al. does not teach the new limitation of "to inform the user that the new mail has been found in said mail server so that the user may, at the user's option, immediately retrieve said new mail," Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.



Art Unit: 2157

18. Applicant argues that none of the features taught by Hortsmann has anything to do with the claimed invention, which involves a simple notification procedure and the message is not forwarded to the user in the claimed invention. In response to Applicant's argument, Figure 9, and column 8, lines 44-67 and column 9, lines 1-10 of the reference are pointed to for emphasis. In this section, the user is able to receive only the subject and the sender of the message, which would constitute a notification, and not the whole message. The original message is retained, column 1, lines 55-63, so there is not forwarding or reformatting of the original message if the user chooses to receive only the subject of the message. If the user wants to retrieve the whole message, it can schedule to poll the server again and receive the whole message, including any attachments, depending on the capability of the electronic device receiving the message, see column 7, lines 29-60, column 8, lines 12-25, and column 9, lines 1-10.

### *Conclusion*

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2157

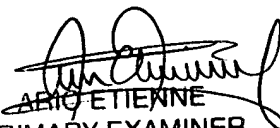
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uzma Alam whose telephone number is (571) 272-3995. The examiner can normally be reached on Monday-Tuesday 5:30 AM - 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uzma Alam  
Ua  
February 23, 2006

  
ARIO ETIENNE  
PRIMARY EXAMINER